

Colorado Bar Association
INTELLECTUAL PROPERTY SECTION
NEWSLETTER

October 2008

Upcoming IP Section Events:

November IP Section Luncheon

November 11, 2008 - Denver Chop House, Large Banquet Room

***In re Bilski* - The En Banc Opinion and The Future of Section 101 Cases**

The IP Section is pleased to announce a luncheon event featuring:

David Hanson, *Director and Partner, Webb Law Firm*, is the attorney that argued on behalf of Mr. Bilski before the *en banc* panel of the Federal Circuit on May 8, 2008;

Tom Krause, *Associate Solicitor U.S. Patent & Trademark Office*, litigates and provides advice in various IP matters for the PTO. He was heavily involved in the *In re Bilski* and *In re Nuijten* cases, and has extensive knowledge and experience on Section 101 cases.

This moderated event will discuss the *In re Bilski* case, the (anticipated) *en banc* opinion of the Federal Circuit, and the future landscape for Section 101 cases.

Cost: \$45 for IP Section Members and CU/DU Law Students may attend for free. Reservations and cancellations for the monthly luncheon must be made prior to 2:00 p.m. Monday, November 10, 2008. RSVP by calling (303) 860-1115 ext. 727 or by e-mailing lunches@cobar.org. When making your reservation, specify that you are attending the November IP Section Lunch, and include your name (and spelling), email address and phone number.

December IP Section Luncheon

December 3, 2008 - Denver Chop House, Large Banquet Room

1 Ethics Credit (Pending Approval)

In *Medtronic Navigation, Inc. v. BrainLAB Medizinische Computersystems GMBH*, 417 F.Supp.2d 1188 (D.Colo. 2006), *aff'd*, 222 Fed.Appx. 952 (Fed. Cir. 2007), Judge Matsch set aside a \$51 million jury verdict in favor of Medtronic, granted summary judgment of non-infringement in favor of BrainLAB and ordered sanctions against Medtronic and its attorneys, McDermott, Will & Emery. Earlier this month, Judge Matsch ordered Medtronic and its attorneys to pay \$4.4 million in attorneys' fees and costs to BrainLAB. The IP Section is pleased to announce that Jay Campbell, lead trial counsel for BrainLAB will present on the lessons learned from the *Medtronic v. BrainLAB* case, and the ethical pitfalls of advocating

infringement/non-infringement positions after a claim construction ruling. More details about this exciting event will be announced soon.

January IP Section Luncheon

January 20, 2009 - CableLabs, Louisville, CO

The IP Section is pleased to announce that CableLabs has agreed to host the January IP Section Luncheon. The event will involve a Venture Capitalist Panel with Moderator to discuss IP issues facing early stage companies and the attorneys that represent them. More details about this event will be announced soon. The IP Section thanks Jud Cary for agreeing to host this event.

September IP Section Luncheon Report Open Source Update 2008

On September 16, 2008 at the Denver Chop House, Maria Woods, General Counsel of StillSecure, and Jason Haislmaier of Holme Roberts & Owen, LLP, gave an update on the happenings in the world of Open Source Software (OSS). Maria and Jason reported on the series of copyright infringement lawsuits seeking to enforce the popular GPL license. Also, the patent infringement cases brought against developers of Linux and other OSS were discussed. The bulk of the presentation was devoted to ensuring compliance in this rapidly changing environment. Maria and Jason underscored the importance of treating OSS just like any other software that is subject to a copyright license. There should be a policy in place governing if and how OSS is brought into the enterprise, and once there, how its propagation is controlled. Each OSS license should be carefully studied so that the various requirements are understood and complied with. Finally, the usage of each OSS package should be identified and tracked to ensure continuing compliance. Although the open source community has historically avoided resolving disputes through the court system, recent events have shown that companies that do not implement their own OSS compliance program will find themselves being required to do so through litigation.

This report was prepared by Lucky Vidmar, Greenberg Traurig, LLP,

Other Events:

Silicon Flatirons Conference

October 17, 2008, 8:30 AM -1:30 PM, The Cable Center, Denver

The Structure of the Video Programming Industry: Revolution, Regulation, or The Return of Yesterday's Battles?

The conference will address the changing industry structure by focusing on three distinct set of themes--the opportunities and challenge of independent networks; the role of access regulation; and the impact of new technologies. In terms of the rise of independent networks, some view the challenges of the NFL Network and claim that the barriers to entry are simply too great. Others, however, suggest that the legacy model of cable networks is unsustainable in the face of continually rising programming costs and opportunities for distribution via the Internet. As to access regulation, the re-authorization of the program access rules and recently

initiated proceeding looking at cable network bundling reflect concerns about market power and vertical integration. For the cable industry, the increasing regulatory attention at a time of increasing competition is difficult to understand. Any new regulatory initiatives (or continuation of old ones) must grapple with the impact of new technologies, particularly those related to the Internet, and the question of whether TV viewing will be liberated from the traditional delivery channels and available in multi-forms and in different media or will continue to rely on intermediaries in a world where viewing habits may well be stubborn and resistant to change. For more information, visit <http://www.silicon-flatirons.org>.

October INTA Roundtable

October 30, 2008 - Westin Tabor Center, 1672 Lawrence Street

Internet Enforcement – “Who, What, and Where Are We to Search”?

These roundtables are developed for trademark administrators and paralegals, and will focus on internet enforcement, covering: securing trademark and domain name registrations; Internet issues for brand owners & IP Professionals; and Internet Protection Strategies and Policies This Roundtable will be hosted by Heidi Nustvold of Thomson CompuMark. For more information contact Heidi at 1-612-874-0262 or heidi.nustvold@thomson.com.

Call for Suggestions or Ideas

The IP Section Officers are also soliciting your suggestions and ideas for topics and speakers for our Luncheon programs for 2009. The following is a list of topics that we are considering for future programs. Please forward any comments you may have to John Posthumus at posthumusj@gtlaw.com:

1. International Patent Protection Panel
2. User Generated Content and IP Issues
3. Export Control
4. Colorado Federal District Court Judge: Viewpoint on Claim Construction Hearings
5. Mock Licensing Negotiation
6. The Use of Mock Juries and Trials
7. Electronic Discovery Issues in IP Cases
8. The Use of Surveys in Trademark Infringement and Dilution Litigation
9. Copyright Exhaustion

IP Newsletter

Subject to editorial discretion and review, the IP Section newsletter is open to the submission of short articles and columns on IP topics of interest. If you are interested in contributing, please contact John Posthumus at posthumusj@gtlaw.com.

IP Section Website

Don't forget to check out the newly overhauled Colorado Bar Association website. Please refer to it often for updates on news and events.

<http://www.cobar.org/group/index.cfm?EntityID=PATENT>

The Colorado Bar Association has posted member directories for each practice section on-line. See ours at:

<http://www.cobar.org/directory/sections.cfm?section=PATENT>

Our contact at the Colorado Bar is Melissa Nicoletti, the Director of Sections and Committees. She can be reached at (303) 824-5321, or melissan@cobar.org.

Recently Filed U.S.D.C. Colorado Cases

CAPTION	TYPE	CASE NO.	JUDGE	FILING ATTORNEY(S) - Local
Baines Ultra Inc. v. Everest Development Company LLC	Trademark Infringement	08cv2021	Marcia S. Krieger	John 'Jack' Markham Tanner Fairfield & Woods, P.C. Daniel J. Warren Sutherland, Asbill & Brennan, LLP-Atlanta
Brown Palace Hotel Associates, LP v. Brown's Palace LLC	Trademark Infringement (Lanham Act)	08cv02069	Zita L. Weinshienk	Timothy P. Getzoff Holland & Hart, LLP
Collins, Arthur A. v. Qwest Communications International Inc.	Patent Infringement	08cv2013	Edward W. Nottingham	Brian D. Smith Brian D. Smith, PC
Davis v. Iris Ink	Trademark Infringement	08cv2085	Wiley Y. Daniel	Elizabeth C. Lewis David A. Sprecece, P.C.
F3 Amusements, LLC v. Thrill-Ville USA, Inc.	Trademark Infringement	08cv02073	Robert E. Blackburn	Scott T. Kannady Brown & Kannady, LLC
GO Fast Sports & Beverage Company et al v. Buckner et al	Trademark Infringement	08cv2149	Marcia S. Krieger	Michael Paul Miller Mollie B. Hawes Miller & Steiert
Harrow Sports, Inc. v. Warrior Sports, Inc.	Patent	08cv1960	Robert E. Blackburn	Conor Fitzgerald Farley Holland & Hart, LLP
Home Design Services, Inc. v. Wade	Copyright Infringement	08cv1982	Robert E. Blackburn	Ian Thomas Holmes Parrish, Lawhon & Yarnell, PA Naples, FL
Home Design Services, Inc. v. Chris Kendrick Construction et al.	Copyright Infringement	08cv1978	Wiley Y. Daniel	Ian Thomas Holmes Anthony M. Lawhon Parrish, Lawhon & Yarnell, PA Naples, FL
Home Design Services, Inc. v. Michael S. Roberts, et al.	Copyright Infringement	08cv1927	Richard P. Matsch	Floyd S. Yarnell Parrish, Lawhon & Yarnell, PA Naples, FL
Ideawerks, LLC v. Worth Home Products, LP	Patent Infringement	08cv2087	Edward W. Nottingham	William David Byassee Jackson Kelly, PLLC
Labnet, Inc. v. Bricton & Cohn	Trademark	08cv2106	Lewis T. Babcock	Daniel A. Thomson Emerson, Thomson & Bennett, LLC Kenneth R. Stettner Stettner Miller, PC

CAPTION	TYPE	CASE NO.	JUDGE	FILING ATTORNEY(S) - Local
Qwest Communications International Inc. v. Iqwest Technologies, Inc.	Trademark Infringement	08cv1969	Wiley Y. Daniel	Christopher P. Beall Levine Sullivan Koch & Schulz, L.L.P.
RE/MAX International v. Gateway Realty Services	Trademark Infringement	08cv2044	Richard P. Matsch	John R. Posthumus Gayle L. Strong Amber J. Sayle
Shambhala International (Vajradhatu) v. Church of Shambhala Vajradhara Maitrey Sangha	Trademark Infringement	08cv1936	Lewis T. Babcock	Kimberly M. Hult William D. Meyer Hutchinson, Black and Cook, LLC
Zimmerman v. Himmelman Construction, et al	Copyright Infringement	08cv2057	Richard P. Matsch	David Akers Weinstein David A. Weinstein, Law Offices

JurisNotes (October 2008)

Patent Cases

Janssen Pharmaceutica, N.V. v. Apotex, Inc. (Fed. Circ. 9/4/08)

Harm that created controversy ceased upon stipulation.

The trial court granted Janssen's motion to dismiss Apotex's counterclaims for lack of subject matter jurisdiction and the Federal Circuit affirmed. Apotex stipulated to the validity, infringement, and enforceability of the '663 patent in May 2007. Thus, while the harm that created a justiciable controversy was present when Apotex filed its counterclaims in April 2006, that harm ceased to exist upon Apotex's stipulation. As such, the harm that gave rise to jurisdiction over the declaratory judgment claims was no longer present at the time that the trial court dismissed this action. The harm that had continuously existed in this case (Apotex's inability to launch its generic product immediately upon expiration of the '663 patent) was not sufficient to give rise to declaratory judgment jurisdiction. The alleged harm of indefinite delay of approval was too speculative to create an actual controversy.

Neuralstem, Inc. v. StemCells, Inc. (D.Md. 8/27/08)

Evidence showed existence of an actual controversy.

The court granted in part and denied in part SCI's motion to dismiss. SCI's press release, in which SCI vaunted its confidence that any third-party wishing to use neural stem cells as potential therapeutics or drug screening tools would have to seek a license from SCI, SCI's policy of enforcing its patents through litigation, and the history between the parties with respect to the involved technology amply supported a finding of an actual controversy. Even more telling was the fact that SCI filed its infringement action in California just hours after Neuralstem filed this declaratory judgment action. Further, the court was satisfied that there existed specific jurisdiction over SCI in Maryland. SCI purposefully availed itself of the privileges and benefits of this forum by filing the 2006 Maryland action, which involved the same parties and was related to the same transaction or occurrence as this matter.

Medtronic Vascular, Inc. v. Boston Scientific Corp. (E.D.Tex. 8/28/08)

Patent agent chose to remain deliberately ignorant.

After Medtronic obtained a jury verdict of infringement, the court conducted a bench trial to resolve various defenses asserted by BSC. Regarding the issue of inequitable conduct, it was clear that Crittenden, Medtronic's in-house patent agent, was substantially involved in the prosecution of the Fitzmaurice patents and that as a result, he owed a duty of candor to the PTO in the prosecution of these patents. Crittenden clearly had knowledge of the Sprint catheter, which the court found was highly material and not cumulative prior art. By relying only on the internal invention disclosure statement prepared by the inventors, Crittenden, at best, chose to remain deliberately ignorant as to the scope of the invention. In short, Crittenden cultivated deliberate ignorance of what a reasonable examiner would consider material art. Therefore, Crittenden acted with the intent to deceive the PTO.

Medical Solutions, Inc. v. C Change Surgical LLC (Fed. Cir. 9/9/08)

Demonstration of device at trade show was not "use."

The trial court dismissed MSI's suit for lack of personal jurisdiction over Change. Because Change's demonstration of the allegedly infringing device at a trade show did not constitute a "use" under patent law, the Federal Circuit affirmed. The trial court correctly considered and interpreted all of the facts with regard to Change's "use" of the allegedly infringing device at the trade show. Change's trade show activities fell short of practicing all of the elements of any one claim. None of Change's activities at the trade show constituted putting the device at issue into service. Even if a Change representative took a basin off an accused device during the trade show, that alone would not establish that the device was put into service so as to constitute an infringing use.

ExcelStor Tech., Inc. v. Papst Licensing (Fed Cir 9/16/08)

Claims did not require resolution of patent law question.

In 2004, EST, a maker of computer products, entered into a licensing agreement with Papst, whereby the latter allowed EST to manufacture patented hard drive disks in exchange for royalty payments. The agreement also required Papst to notify EST of the existence of any other royalty-bearing licenses for the drives. EST became aware of a license agreement between Papst and Hitachi Corporation. EST's complaint alleges that Papst violated the patent exhaustion doctrine by collecting two royalty payments from the sale of the same drives. The the trial court correctly concluded that it lacked subject matter jurisdiction over EST's claims and the Federal Circuit affirmed. EST contended that certain of its claims arose under the patent exhaustion doctrine and therefore, were within the jurisdiction of the federal courts. However, patent law did not create the cause of action in this case; patent exhaustion was a defense to patent infringement, not a cause of action. Furthermore, EST's claims did not establish federal subject matter jurisdiction because they did not require resolution of a substantial question of federal patent law. The complaint in this matter did not allege that

Papst invoked patent law to control the post-sale use of the hard disk drives at issue, but instead alleged that Papst violated the patent exhaustion doctrine by collecting two different royalties from the same patented product. There was no federal cause of action for collecting royalties twice on the same goods. While such actions could constitute a breach of contract or fraud, patent law was not a necessary element of such determinations.

The Campbell Pet Co. v. Miale (Fed. Cir. 9/18/08)

Acts exceeded attempts to inform of alleged infringement.

The trial court held that Miale's activities in Washington were not sufficient for it to exercise personal jurisdiction over defendants. The Federal Circuit disagreed and therefore, reversed the dismissal of the complaint. Defendants had purposefully engaged in transactions in Washington during the convention in question and the claim for declaratory judgment of non-infringement arose from or was connected with those transactions. Contrary to the trial court's findings, Miale's attempts at extra-judicial patent enforcement were targeted at Campbell's business activities in Washington and could fairly be characterized as attempts to limit competition from Campbell at the convention. Those efforts went beyond simply informing Campbell of the allegations of infringement. In fact, defendants took steps to interfere with Campbell's business.

Taser Int'l., Inc. v. Stinger Systems, Inc. (D.Ariz. 9/5/08)

Particulars of inequitable conduct were sufficiently alleged.

The court denied Taser's motion to dismiss or strike Stinger's inequitable conduct defense for failure to plead with particularity. Stinger had sufficiently set forth the particulars of Taser's alleged inequitable conduct in the prosecution of the '295, '870, and '262 patents before the PTO. Stinger had identified the prior art that it contended was withheld from the PTO with sufficient detail so that Taser could defend against the charge of inequitable conduct. Stinger did not need to identify by name the individuals who were involved in the preparation or prosecution of the applications at issue. Taser was in possession of the "who" that was substantively involved in these activities. In addition, Stinger had specifically indicated the grounds for its contentions by referring to the examiner's statements and drawing comparisons between the alleged prior art and the claimed inventions.

Egyptian Goddess, Inc. v. Swisa, Inc. (Fed. Cir. 9/22/08)

Court discards point of novelty test in design patent cases.

The Federal Circuit agreed to rehear this case to address the appropriate legal standard to be used in assessing claims of design patent infringement. The trial court granted summary judgment of non-infringement in favor of Swisa and the Federal Circuit affirmed. In doing so, the Federal Circuit held that the point of novelty test, as a second and free-standing requirement for proof of design patent infringement, was inconsistent with the ordinary observer test and was not needed to protect against unduly broad assertions of design patent

rights. Here, in light of the similarity of the prior art buffers to the accused buffer, the Federal Circuit determined that no reasonable fact-finder could conclude that EGI had met its burden of showing that an ordinary observer (taking into account the prior art) would believe the accused design to be the same as the patented design.

Aristocrat Technologies v. Int'l. Game Tech. (Fed. Cir. 9/22/08)

Improper revival is not a viable defense in patent suits.

The trial court concluded that the PTO "improperly revived" the '215 patent after it was abandoned during prosecution and therefore held it (and the continuation patent that followed it) invalid on summary judgment. The Federal Circuit concluded that "improper revival" was not a cognizable defense in an action involving the validity or infringement of a patent. Congress made it clear in various statutory provisions when it intended to create a defense of invalidity or non-infringement, but indicated no such intention in the statutes pertaining to revival of abandoned applications. The provisions at issue merely spelled out under what circumstances a patent application was deemed abandoned during prosecution and under what circumstances it could be revived.

Advanced Cardiovascular v. Medtronic Vascular (D.Del. 9/26/08)

Relationship between infringement and losses was clouded.

The court denied AC's motion for a permanent injunction, noting that although Medtronic was gaining market momentum, it appeared to be not only at the cost of AC. Thus, the relationship between Medtronic's infringement and AC's losses was clouded. AC had not addressed the fact that Boston Scientific Corporation held a larger market share than Medtronic. Moreover, AC had not identified any specific customers it had lost, or stood to lose, directly as a result of Medtronic's continued sales of infringing stents. AC admitted that it had recaptured nearly all of the market share lost to Medtronic and was currently the leading producer of bare-metal stents. The court found no irreparable harm on this record. In addition, AC's willingness to forego its patent rights for compensation supported the court's conclusion that AC would not suffer irreparable harm absent an injunction. Finally, there was a strong public interest in maintaining diversity in the coronary stent market.

Copyright Cases

Warner Bros. Entertainment, Inc. v. RDR Books (SDNY 9/8/08)

Harry Potter encyclopedia did not constitute a fair use.

The court found in favor of Warner after conducting a bench trial in this matter. Warner easily established a prima facie case of infringement and the court ultimately determined that RDR's encyclopedia was not a fair use of the underlying Harry Potter works. The encyclopedia was transformative (though not consistently) because it used material from the series for the practical purpose of making information about the world of Harry Potter readily accessible to readers. Although it was necessary for RDR's book to make considerable use of the original

works in order to fulfill its purpose as a reference guide, the court was troubled by the verbatim copying of the highly aesthetic expression contained in the Harry Potter works. While RDR's book was unlikely to serve as a market substitute for the Harry Potter series, publication of it could harm sales of Rowling's two companion books.

Asset Marketing Systems, Inc. v. Gagnon (9th Cir. 9/9/08)

Party held an implied unlimited license for programs.

The trial court granted summary judgment in favor of Asset and the 9th Circuit affirmed. Gagnon alleged that Asset infringed his copyright in six programs that he wrote for Asset by continuing to use and modify them without Gagnon's consent and that Asset misappropriated trade secrets contained in the source code. However, as the trial court correctly concluded, Gagnon had granted Asset an unlimited, nonexclusive, implied license to use, modify, and retain the source code of the programs. The programs were created specifically for Asset and it paid for the work related to drafting the programs. In addition, Gagnon delivered the programs to Asset when he installed them onto Asset's computers and stored the source code on-site. Gagnon's conduct manifested an objective intent to give Asset an unlimited license.

Stuart Weitzman, LLC v. Microcomp. Resources (11th Cir. 9/12/08)

Trial court lacked subject matter jurisdiction to hear suit.

The trial court granted summary judgment in favor of Weitzman in this declaratory judgment action. The 11th Circuit vacated and remanded with instructions to dismiss this case for lack of subject matter jurisdiction. The most logical reading of the complaint suggested that Weitzman anticipated a copyright infringement suit by Micro. Because Micro had not applied for a copyright on the disputed program, much less received or been denied one, the trial court would lack subject matter jurisdiction if Micro brought an infringement suit against Weitzman. Weitzman also posited that Micro might bring state law claims that would be preempted by the [Copyright Act](#). However, the trial court would be required to dismiss such a federal copyright infringement claim as explained above.

Muniz v. Morillo (SDNY 9/10/08)

Alleged bad acts did not suspend registration requirement.

The court granted Morillo's motion for judgment on the pleadings, noting that Muniz's application for copyright registration had not yet been approved or rejected by the Copyright Office. Muniz asserted that Morillo's "bad acts" (namely, taking possession of Muniz's media) were the reason for the delay in filing the application for copyright registration. Muniz argued that the court had flexibility to grant an extension of time to meet the jurisdictional requirement before dismissing his claim. However, there was no authority for the assertion that a defendant's bad acts should suspend the registration requirement for jurisdiction to bring a claim for copyright infringement. Put simply, the court had no authority to ignore the statutory requirements and accordingly, dismissal of this claim was appropriate.

CA, Inc. v. Rocket Software, Inc. (EDNY 9/17/08)

Actions showed diligence in pursuing discovery of claims.

The court granted in part and denied in part Rocket's motion to dismiss. Rocket contended that any activity occurring before April 9, 2004 was time-barred for the purposes of CA's copyright infringement claims. In the court's view, however, CA had adequately alleged fraudulent concealment. CA's actions in repeatedly contacting Rocket and asking it to investigate possible misuse of CA's intellectual property, as well as its attempts to arrange inspection of Rocket's source code, amounted to nothing less than diligence in pursuing discovery of CA's claims. Rocket's repeated, detailed assurances that its product was independently developed and that no person involved in engineering its program had any access to or knowledge of CA's DB2 database administration products, if untrue, went beyond merely preventing CA from gathering evidence in support of its claims.

Barboza v. New Form, Inc. (9th Cir. 9/23/08)

Unclear whether debt arising from violation was willful.

Barboza was found liable by a jury for willful infringement of NFI's copyright for certain Spanish language films. After judgment was entered, Barboza filed for bankruptcy and sought to discharge the judgment award. The bankruptcy judge held on summary judgment that the judgment award was nondischargeable as a willful and malicious injury based on the jury's finding of willful infringement. The BAP affirmed and the 9th Circuit reversed and remanded, noting that a fact issue existed as to whether the infringement was a "willful" injury within the meaning of bankruptcy law. There was simply no way for the bankruptcy court to determine whether the jury found the willful infringement based on a reckless disregard or a knowing violation of NFI's copyright. Injuries resulting from recklessness were not sufficient to be considered willful injuries under bankruptcy law.

Trademark Cases

WMS Gaming, Inc. v. WPC Gaming Productions (7th Cir. 9/8/08)

Court failed to distinguish between profits and damages.

While WMS prevailed in this trademark infringement suit, the trial court applied the wrong standard to its claim for an accounting of profits. The trial court, despite mentioning in passing the proper standard for an accounting of profits, made a fundamental error of law by failing to distinguish between WMS's right to WPC's profits and its right to damages. The trial court did not follow through with two separate computations, one for the accounting and one for damages. The result was that the trial court incorporated into its accounting of profits analysis the additional considerations of whether the "damages" could be ascertained with reasonable certainty and whether WMS had proven that its calculation properly separated out the revenues gained from the lawful business as opposed to infringing uses of WMS's marks.

In re Brunswick Corp. (TTAB not citable 8/28/08)

Specimens did not associate term with party's goods.

Brunswick filed an application to register the mark "Aquapalooza" for boats and related structural parts. The examining attorney refused registration on the ground that the specimens were not acceptable because they did not show the mark used in connection with the goods specified in the application. The Board affirmed the refusal, noting that the specimens referred to a specific event, "Aquapalooza 2006." In the Board's view, the specimens did not associate the proposed mark with the involved goods, but instead promoted a sales event. Thus, the specimens could not be considered as displays associated with the goods. The fact that purchasers would recognize that boats were sold at the "Aquapalooza" event did not establish that this term served as a trademark for those boats.

Hachette Filipacchi Presse v. EV Int'l. (TTAB not citable 9/5/08)

Mark was entitled to broad scope of protection.

EV sought to register the mark "Chez Elle Lingerie" and design for various articles of clothing. HFP opposed registration on the basis of a likelihood of confusion with its previously registered "Elle" marks for magazines, various articles of clothing, and television shows focused on fashion and beauty. The Board sustained the opposition, finding that HFP's mark was famous in connection with its magazine and within the fashion industry generally. As a result, HFP's "Elle" mark was entitled to a broad scope of protection. While EV agreed to modify its specification of goods to limit the coverage to maternity wear, this did not change the analysis inasmuch as HFP's registrations did not exclude this subset of clothing. To the extent that there was some discretion in purchasing EV's maternity wear, it was not sufficient to offset the other factors. Finally, the differences between the marks were not sufficient to distinguish EV's mark from HFP's mark.

In re flexSCAN, Inc. (TTAB not citable 9/3/08)

Beyond shared number, marks had nothing in common.

Flexscan applied to register the mark "Wellness360" and design for providing temporary use of online software for medical records, prescription tracking and management, diet management and planning, and other uses. The examining attorney refused registration on the basis of a likelihood of confusion with the registered mark "Care360" and design for providing temporary use of online software to healthcare professionals for use in maintaining and accessing patient medical records and other uses, as well as for various medical information services. The Board reversed the refusal to register, concluding that beyond sharing the number "360," the two marks had nothing else in common. Further, while "wellness" could result from "care," these words did not mean or imply the same thing.

Talisker Corp. v. Prime West Jordanelle, LLC (D. Utah 9/12/08)

Initial interest confusion was clearly possible in this case.

The court granted TC's motion for a preliminary injunction, ultimately concluded that TC was substantially likely to succeed on the merits of its trademark infringement claim against Prime. TC had shown that Prime was experiencing legal troubles and that if consumers confused

"Talisman" and "Talisker," TC could suffer as a result. Based on the fact that "Talisman" was the name of a real estate development in Wasatch County and that TC used the "Talisker" mark in connection with marketing similar real estate developments in Wasatch and Summit Counties, initial interest confusion was possible in this case. Further, the record clearly supported the inference that, despite its protestations otherwise, Prime intended to benefit from TC's marks. In addition, the record contained convincing evidence of actual confusion, as well as evidence of the strength of TC's marks.

Boston Red Sox Baseball Club v. Sherman (TTAB citable 9/9/08)

Term would be understood as vulgar by purchasing public.

Sherman applied to register the stylized mark "Sex Rod" for various articles of clothing. Red Sox opposed registration on these grounds based on various registered marks that consist of or incorporate the word "Red Sox" in connection with baseball game exhibition services and a wide array of goods, including clothing: 1) likelihood of confusion; 2) that the mark consists of immoral and scandalous matter; 3) that the mark disparages Red Sox; 4) that the mark falsely suggests a connection with Red Sox; and 5) lack of a bona fide intent to use the mark. The Board sustained as to the second, third, and fifth grounds and dismissed the opposition as to the remaining grounds. The evidence was sufficient to show prima facie that the applied-for mark was vulgar. Sherman admitted that the design of his mark was intended to refer to Red Sox. Because the mark was offensive and because the public would associate the offensive message with Red Sox, the mark could disparage Red Sox.

In re Innovative Technologies Corp. (TTAB not citable 9/15/08)

Marks would not be seen as having same idiomatic meaning.

Innovative sought to register the mark "Hair of the Dog" for shirts, pants, shorts, headwear, hats, socks, sleepwear, and dresses. The examining attorney refused registration on the basis of a likelihood of confusion with the registered mark "Les Cheveux Du Chien" for custom manufacture of clothing, jewelry, stoles, scarves, linens, and home decor items. The Board reversed the refusal, though acknowledging that the cited registration included a translation of the mark as meaning "the hair of the dog." In the Board's view, the evidence did not clearly demonstrate that Innovative's mark was equivalent in meaning to the mark in the cited registration. The idiomatic meaning of the phrase "hair of the dog" differed substantially from the literal meaning of the words. There was nothing in the evidence of record indicating that this idiom had the same meaning in French.

United States v. Able Time, Inc. (9th Cir. 9/25/08)

Tariff Act does not contain an identity of goods requirement.

Able imported a shipment of watches into the United States bearing the "Tommy" mark, for which Tommy Hilfiger Licensing, Inc. ("THL") holds various registrations. Customs seized the watches and later imposed a civil penalty on Able. At the time of the seizure, THL did not

make or sell watches. Given this fact, the trial court held that the watches imported by Able were not counterfeit. The 9th Circuit reversed and remanded, holding that the [Tariff Act](#) did not contain an identity of goods or services requirement. Therefore, it was lawful for Customs to impose a civil penalty on an importer of merchandise bearing a counterfeit mark even though the owner of the registered mark did not manufacture or sell the same type of merchandise. The plain language of the relevant statutes was unambiguous and did not contain an identity of goods or services requirement.

Southern Grouts & Mortars, Inc. v. 3M Co. (S.D.Fla. 9/17/08)

Under facts, plaintiff's claims were clearly barred by laches.

The court granted 3M's summary judgment motion, holding that SGM's claims were barred by laches. There was no dispute that SGM knew of 3M's ownership of the domain name at issue as early as July 2002 and yet, it failed to file suit until September 2007. In the time between, SGM sent one email and two letters to 3M; 3M clearly responded to the two letters, declining to relinquish the domain name and asserting its right to the name. SGM's argument that this delay in filing suit should be tolled because it acted diligently in attempting to resolve this matter with 3M was belied by the record. Further, SGM's involvement in other litigation and 3M's alleged notice of SGM's claims did not excuse the delay. Further, 3M argued that it had suffered evidentiary prejudice as a result of the delay.

Schussler v. Webster (S.D.Cal. 9/22/08)

Party did not use mark in sufficiently commercial manner.

The court granted Schussler's motion for summary judgment as to his claim for a declaration of trademark rights. Webster had been using "The Hot Dog Hall of Fame" to describe his activities for approximately thirty years. However, the uses asserted by Webster were not sufficiently commercial when viewed individually and in their entirety. Mere registration of a domain name did not constitute use in commerce. Further, Webster intentionally made his website difficult to access by the public and never generated or attempted to generate any revenues from the site. Webster only added a store to his site after the commencement of this suit. Additionally, any trademark rights acquired by Webster in 1983 (via use of the mark on the wall of a restaurant for about six months) had been abandoned. Webster's miscellaneous activities had not included any commercial component.

Domain Name Cases

Diners Club International Ltd. v. Self (NAF 8/14/08)

Party's current use of domain name was not a pretext.

The panel had no difficulty in finding that the domain name "dinerss.com" was confusingly similar to DCI's "Diners" mark. However, the panel reached the opposite conclusion as to the "dinerreward.com" domain name. "Diners" was a weak mark and this latter domain name was not a close match to that mark. The addition of the word "reward," whether or not descriptive of DCI's services, created a different overall impression for the second disputed domain name.

In addition, the panel believed that respondent's current website constituted a bona fide offering of goods and services and that this use was not competitive with DCI's services. Moreover, the panel believed that respondent's current use of the domain name "dinerss.com" was not a pretext and that this use was always respondent's intention.

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IP Section Officer Contact Information

Chair:

Clay James, Esq.
Sun Microsystems, Inc.
500 Eldorado Boulevard
UBRM01-205
Broomfield, CO 80021
303.272.7769
clayton.james@sun.com

Vice-Chair:

Michael Drapkin, Esq.
Townsend and Townsend and Crew
1200 17th Street, Suite 2700
Denver, CO 80202
303.571.4000
mldrapkin@townsend.com

Secretary/Treasurer:

John Posthumus, Esq.
Greenberg Traurig, LLP
1200 17th Street, Suite 2400
Denver, CO 80202
303.572.6500
posthumusj@gtlaw.com

All correspondence, phone calls, facsimiles and emails concerning this newsletter, as well as advertising submissions should be directed to John Posthumus at posthumusj@gtlaw.com.